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OFFICE OF PETITIONS

In re Application of
Subhankar Chatterjee et al
Application No. 09/538,024
Filed: March 29, 2000
Attorney Docket No. C-481B

:
:DECISION DISMISSING PETITION
:UNDER 37 CFR 1.137(b)
:
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This is a decision on the petition under 37 CFR 1.137(b), filed October 3, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 18, 2001, which set a shortened statutory period for reply of three (3) months. A two month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on May 19, 2002.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed;
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
- (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c).

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). **The instant petition lacks items (1), (2) and (3).**

As to item (1), the petition to revive was accompanied by a request for continued examination (RCE) under 37 CFR 1.114, which states that the enclosed continuation-in-part application is the submission.

37 CFR 1.114 provides that, if prosecution in an application is closed, ***an applicant may request continued examination of the application by filing a submission*** and the fee prior to the earliest of (1) payment of the issue fee, unless a petition under § 1.313 is granted; (2) abandonment of the application; or (3) the filing of a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or commencement of a civil action.

Prosecution in an application is closed when the application is under appeal, ***or the last Office action is a final action (§ 1.113)***, a notice of allowance (§1.311) has been mailed, or contains an action that otherwise closes prosecution of the application (i.e., Ex parte Quayle).

In the instant application, since prosecution has closed, the filing of an RCE is proper. However, the RCE is not accompanied by the submission required by 37 CFR 1.114. In this regard, the submission accompanying the RCE must be a reply responsive within the meaning of 37 CFR 1.111 to the last Office action. The submission may be a previously filed amendment after final. *See* MPEP Section 711.03(c), subsection (d) Filing of an RCE as the Required Reply, page 700-143. In the instant case, petitioner has indicated that the submission is the filing of a continuation-in-part application. However, the filing of a continuation-in-part application is not a proper submission under 37 CFR 1.114. Accordingly, a submission as required by 37 CFR 1.114 must be submitted to revive the instant application.¹

¹ The Office has charged two fees for the RCE and filing fees for the continuing application papers. Since only one fee is necessary for the filing of an RCE, one of the \$740 fees processed will be credited to petitioner's deposit account in due course, as well as the filing fees for the continuation-in-part application papers. In this latter regard, petitioner, Sidney Persley, indicated to the undersigned on October 23, 2002 that he did not wish to have the continuing application papers submitted with the RCE processed.

Further, it is unclear how petitioner wishes to proceed in the prosecution of this application since the RCE submission is the filing of the papers for a continuation-in-part application. If petitioner still desires to prosecute the instant application, a submission, as set out above, is required. If, on the other hand, petitioner does not wish to further prosecute the instant application and desires to abandon the application in favor of a continuing application, such statement must be supplied, along with a statement of express abandonment. Also, if petitioner does wish to proceed with continued examination in the instant application and does not wish to have the continuing papers submitted with the petition processed, a statement to disregard the continuing application papers must be included in the renewed petition; otherwise, the Office will proceed with processing the papers submitted with the petition as a new application.

As to item (2), the petition fee required by statute did not accompany the instant petition to revive. The petition fee is required before any further consideration on the merits of the petition will be undertaken.

As to item (3), the petition lacks the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional."

In sum, revival of this application cannot be effected until the following requirements of 37 CFR 1.137(b) have been satisfied: (1) a submission as required by 37 CFR 1.114, or the filing of a continuing application, along with a statement of express abandonment (if it is desired to continue prosecution by way of a continuing application); (2) the petition fee required by statute; and (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional."

In order to expedite revival of this application, petitioner may wish to consider submitting the items required by this decision on petition in a renewed petition under 37 CFR 1.137(b) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
P.O. Box 2327
Mail Stop DAC
Arlington, VA 22202

OR

Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680 (work days are Monday through Thursday).



Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy